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| 09/981,213 | 10/17/2001 | Johan Renes | 5117US | 5776 |
| 24247 | 7590 | 08/08/2006 | EXAMINER | |
| TRASK BRITT P.O. BOX 2550 SALT LAKE CITY, UT 84110 | | | GILLIGAN, CHRISTOPHER L | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3626 | |

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 09/981,213 | Applicant(s) RENES ET AL. | |
| | Examiner Luke Gilligan | Art Unit 3626 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. In the amendment filed 5/18/06, the following has occurred: claims 1-17 have been amended. Now, claims 1-20 are presented for examination.
2. The rejections under 35 U.S.C. 101 and 112 have been withdrawn by the Examiner based on changes made by Applicants to the claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 5, 8-10, 12-13, 16, 18, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Golden, **Breaking Up Without Going Broke** (paragraphs numbered by Examiner).
5. As per claim 9, Golden discloses a method of doing business comprising: determining a periodic amount to be charged a prospective participant for insurance covering at least some financial consequences of the untimely ending of a contractual relationship between two or more natural persons (see paragraph 15); charging that periodic amount in an insurance program over a period of time (see paragraph 15); and administering the insurance program (see paragraphs 15 and 16); wherein the insurance program requires a minimum duration of the charges of the periodic amount before any coverage is obtained, said minimum duration

Art Unit: 3626

comprising three years (see paragraph 18, note that a minimum duration of five years, as disclosed, covers a minimum duration of three years).

6. As per claim 12, Golden discloses a method of doing business comprising: determining a periodic amount to be charged a prospective participant for insurance covering at least some financial consequences of the untimely ending of a contractual relationship between two or more natural persons (see paragraph 15); charging that periodic amount in an insurance program over a period of time (see paragraph 15); and administering the insurance program (see paragraphs 15 and 16); wherein the charges for the periodic payment start either at or before the beginning of the contractual relationship between the two or more natural persons (see paragraph 19).

7. As per claim 1, Golden discloses the method of claim 12 as described above. Golden further discloses said natural persons are living together (see paragraph 15, the Examiner interprets a married couple to be "living together" as recited).

8. As per claim 2, Golden discloses the method of claim 1 as described above. Golden further discloses said natural persons are legally married (see paragraph 15).

9. As per claim 3, Golden discloses the method of claim 2 as described above. Golden further discloses said untimely ending comprises a divorce between the natural persons (see paragraph 15).

10. As per claim 5, Golden discloses the method of claim 1 as described above. Golden further discloses said insurance program is part of another contract (see paragraph 15, note that the divorce insurance is offered as a part of the company's legal insurance).

11. As per claim 8, Golden discloses the method of claim 12 as described above. Golden further discloses the prospective participant is one of the two or more natural persons (see paragraph 15).

Art Unit: 3626

12. As per claim 10, Golden discloses the method of claim 12 as described above. Golden further discloses limiting coverage for a certain time interval after the initiation of said contractual relationship (see paragraph 18).

13. As per claim 16, Golden discloses the method of claim 12 as described above. Golden further discloses the periodic amount charged one of the two or more natural persons is changed in view of changed circumstances in that natural person's life (see paragraph 18).

14. As per claim 18, Golden discloses the method of claim 12 as described above. Golden further discloses the periodic amount is a monthly amount (see paragraph 15).

15. As per claim 20, Golden discloses the method of claim 12 as described above. Golden further discloses means to prevent fraud (see paragraph 18, the examiner considers the time limit to avoid problems with "quickie divorces" to be a form of "means to prevent fraud" as recited").

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 4, 11, 14-15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Golden, **Breaking Up Without Going Broke** (paragraphs numbered by Examiner) in view of Covert, U.S. Patent Application Publication No. 2005/0038681.

18. As per claim 4, Golden discloses the method of claim 1 as described above. Golden does not explicitly disclose a combination of other financial risks with some financial consequences of the untimely ending of a contractual relationship between natural persons in

Art Unit: 3626

said insurance program. However, Covert teaches an insurance program that covers some financial consequences of the untimely ending of a contractual relationship between natural persons with other financial risks of the two or more natural persons (see paragraph 0036). It would have been obvious to one of ordinary skill in the art at the time of the invention to add coverage for additional financial risks of the two or more natural persons to the insurance program disclosed by Golden. One of ordinary skill in the art would have been motivated to add such coverage for the purpose of providing protection against additional expenses beyond those associated with the divorce itself (see paragraphs 0032-0033).

19. As per claim 11, Golden discloses the method of claim 12 as described above. Golden does not explicitly disclose the charges for the periodic payments are paid by an entity not being one of the two or more natural persons in said contractual relationship. Covert teaches an insurance program that covers some financial consequences of the untimely ending of a contractual relationship between natural persons and wherein the charges for the periodic payments are paid by an entity not being one of the two or more natural persons in said contractual relationship (see paragraph 0061). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such teachings from Covert into the method disclosed by Golden for the reasons given above with respect to claim 4.

20. As per claim 14, Golden discloses the method of claim 12 as described above. Golden does not explicitly disclose the periodic amount to be charged a prospective participant is based, in part, on the prospective participant's projected earnings. Covert teaches an insurance program that covers some financial consequences of the untimely ending of a contractual relationship between natural persons and wherein the periodic amount to be charged a prospective participant is based, in part, on the prospective participant's projected earnings (see paragraph 0036). It would have been obvious to one of ordinary skill in the art at the time of the

Art Unit: 3626

invention to incorporate such a feature into the method of Golden. One of ordinary skill in the art would have been motivated to incorporate such a feature for the purpose of tailoring premiums to characteristics of the participants (see paragraph 18 of Golden).

21. As per claim 15, Golden discloses the method of claim 12 as described above. Golden does not explicitly disclose the periodic amount to be charged a prospective participant is based, in part, on the prospective participant's partner's projected earnings. Covert teaches an insurance program that covers some financial consequences of the untimely ending of a contractual relationship between natural persons and wherein the periodic amount to be charged a prospective participant is based, in part, on the prospective participant's partner's projected earnings (see paragraph 0036). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a feature into the method of Golden. One of ordinary skill in the art would have been motivated to incorporate such a feature for the purpose of tailoring premiums to characteristics of the participants (see paragraph 18 of Golden).

22. As per claim 17, Golden discloses the method of claim 16 as described above. Golden does not explicitly disclose that the change circumstances are selected from the listed group. Cover teaches an insurance program that covers some financial consequences of the untimely ending of a contractual relationship between natural persons and wherein changed circumstances are selected from the listed group (see paragraph 0036). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such teachings from Covert into the method disclosed by Golden for the reasons given above with respect to claim 14.

Art Unit: 3626

23. Claims 6-7 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Golden, **Breaking Up Without Going Broke** (paragraphs numbered by Examiner) in view of Mooney, **Could Insurers Find Bliss In Divorce Market ?** (paragraphs numbered by Examiner).

24. As per claim 6, Golden discloses the method of claim 1 as described above. Golden does not explicitly disclose providing a payment to the two or more natural persons at an end date of insurance coverage in the event the contractual relationship between the two or more natural persons does not end untimely. Mooney discloses a divorce insurance product that suggests providing a payment to married couples at an end date of insurance coverage in the event that the marriage does not end untimely (see paragraph 12). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a provision into the method of Golden. One of ordinary skill in the art would have been motivated to incorporate such a provision for the purpose of providing an incentive to maintaining the marriage (See paragraph 12 of Mooney and paragraph 10 of Golden).

25. As per claim 7, Golden in view of Mooney disclose the method of claim 6 as described above. Golden does not explicitly teach a payment dependent on investment of the periodic amounts paid on behalf of said natural persons for said insurance policy. Mooney further discloses that the payment is dependent on investment of the periodic amounts paid on behalf of said natural persons for said insurance policy (see paragraph 12, note that Mooney suggests structuring this feature like a whole life policy). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a provision into the method of Golden for the reasons given above with respect to claim 6.

26. As per claim 19, Golden discloses the method of claim 12 as described above. Golden does not explicitly disclose investing at least a portion of the periodic amount. Mooney

Art Unit: 3626

discloses investing at least a portion of a periodic amount paid for divorce insurance (see paragraph 12, note that Mooney suggests structuring this feature like a whole life policy). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a provision into the method of Golden for the reasons given above with respect to claim 6.

27. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Golden, **Breaking Up Without Going Broke** (paragraphs numbered by Examiner) in view of Flagg, U.S. Patent No. 6,456,979.

28. As per claim 13, Golden discloses the method of claim 12 as described above. Golden does not explicitly disclose the periodic amount to be charged a prospective participant is based, in part, on the prospective participant's age and the prospective partner's age. Flagg teaches an insurance policy that includes basing charge amounts on participant's age (see column 2, lines 13-32). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a feature into the method of Golden. One of ordinary skill in the art would have been motivated to incorporate such a feature for the purpose of tailoring premiums to characteristics of the participants (see paragraph 18 of Golden).

Response to Arguments

29. In the remarks filed 5/18/06, Applicants argue in substance that Covert fails to teach an insurance program that protects against the untimely ending of a contractual relationship between two or more natural persons that is entered into prior to the ending of the contractual relationship as recited in the claims as amended. In response to the amendment to the claims to indicate this characteristic of the insurance program, the Examiner has relied upon a new

Art Unit: 3626

grounds of rejection in view of Golden. Therefore, it is respectfully submitted that the arguments with respect to Covert are now moot in view of the new grounds of rejection detailed above.

30. Applicants further argue that Covert fails to teach that a third party can take out the insurance policy and that the amount to be charged is based, in part, on participant's earnings. With respect to the third party purchasing the policy, it is noted that Covert indicates that the insurance policy may be purchased through "an agent, such as legal counsel, a business advisor, personal representative and/or fiduciary" (see paragraph 0061). It is respectfully submitted that by using such a third party intermediary, Covert teaches this limitation as recited in the claim. Additionally, with respect to the charge amount limitation, it is noted that Covert indicates that an appropriate premium is determined to provide coverage against, among other financial risks, lack of payment of alimony or child support (see paragraph 0036). It is respectfully submitted that alimony and child support are a component of projected earnings. Therefore, a premium for such an insurance policy is based, in part, on such projected earnings.

Conclusion

31. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Malveaux discloses types of premarital insurance.

32. Applicant's amendment specifying when charges for the insurance policy are made necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3626

33. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

34. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (571) 272-6770. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

35. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

36. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

8/1/06


C. LUKE GILLIGAN
PATENT EXAMINER